

## **REMARKS**

Examination on the merits is respectfully requested in light of the foregoing amendments and following remarks. The amendments are made without disclaimer or prejudice to pursuing any deleted subject matter in a continuing application.

**1. Status of the Claims**

Claims 1-30 stand pending and are subject to a restriction requirement. Claims 2, 7, 8, 24, and 25 are presently amended.

**2. Support for the Amendments**

Support for the amendment to claim 2 is found in the claims as originally filed. Claims 7, 8, 24, and 25 are amended solely to comply with formalities related to Sequence Identifiers. The amendments accordingly do not enter impermissible new matter.

**3. Restriction Requirement**

The Office restricted claims 1-30 in to one of the following groups:

**Group I**, claims 1, 2 (in part), 5-6, and 9-15 (in part), allegedly drawn to a DNA construct comprising two “native” restorer protein-encoding constructs having different nucleotide sequences but encoding the same protein, under the control of two different male tissue-specific promoters, and plants containing them; or

**Group II**, claims 2 (in part), 3-4, 7-8, 9-15 (in part), and 16-30, allegedly drawn to a DNA construct comprising two “cytotoxin-reversing” restorer protein-encoding constructs having different nucleotide sequences but encoding the same protein, under the control of two different male tissue-specific promoters, plants containing them, and methods for making them.

**4. Election with Traverse**

Applicants elect **Group I**, claims 1, 2 (in part), 5-6, and 9-15 (in part) with traverse. Traverse is on the following grounds:

(1) The restriction requirement should be reconsidered in light of the present amendment

Upon entry of the amendment, the application would contain only two independent claims: claim 1, directed to a product, and claim 16, directed to a method of using the product of claim 1. These claims are properly examined in the same application under the procedures for examination of a national stage application set forth in 37 C.F.R. § 1.475.

(2) The Office misstates the claimed subject matter

Groups I and II are directed to the *same* DNA construct, namely, a DNA construct containing two different coding sequences of a fertility restorer gene, both of which encode the same protein product, the first of said sequences being a naturally occurring wild type gene sequence and the second of said sequences being a modified sequence generated by modification of the wild type sequence using codon degeneracy for expression in crop plants to avoid homology between the modified sequence and the wild type sequence at the DNA and mRNA levels so as to reduce susceptibility to homology-based post-transcriptional gene silencing, said wild type and said modified gene sequences being under the control of different tissue specific promoters, said different tissue-specific promoters having overlapping expression patterns in male reproductive tissues of said crop plants. The present amendment to claim 2 clarifies this aspect of the claimed subject matter.

Moreover, the Office misstates the claimed subject matter. The Office describes the DNA construct using the terms “native,” “heterologous,” and “cytotoxin-reversing,” but Applicants use none of these terms in the claims. The Office’s allegation that each group involves divergent starting materials thus relies on a misstatement of the claimed subject matter. According, Applicants request the Office to reconsider and withdraw the grouping of the claims.

(3) The Groups are improperly directed to overlapping subject matter

Further, the Office alleges that claims directed to overlapping subject matter are independent and distinct inventions. A dependent claim, by definition, incorporates all the elements of the claim upon which it depends. *See* 35 U.S.C. § 112, fourth paragraph. As to the present application, claims 7-8 depend on claim 5, which further depends on claim 1.

Accordingly, claims 7-8 fully incorporates limitations of claim 1 and/or those of claim 5. Yet, the Office categorizes claims 7-8 in Group II while claims 1 and 5 in Group I. A restriction of groups containing overlapping subject matter is prohibited. *See* MPEP § 806.03. The restriction requirement thus should be modified or withdrawn.

(4) The Office fails to address burden of search

Applicants respectfully traverse the Restriction/Election Requirement, because the Office fails to address the burden of search. Particularly in this case, as the International Preliminary Examining Authority has found unity in the PCT application, there is an increased burden above the already “serious burden” in evincing why a restriction requirement is necessary. *See* Anthony Caputa, “Two Be or Not To Be: or Divide and Conquer: or A Case Divided Cannot Stand: Principles in Restriction Practice TC 1600,” presented December 2004 to the Customer Partnership Meeting, *available at* [www.uspto.gov/web/patents/tc1600restrictionmaterials.pdf](http://www.uspto.gov/web/patents/tc1600restrictionmaterials.pdf). The burden of search, however, was nowhere mentioned in the Restriction/Election Requirement. Accordingly, the Restriction/Election Requirement should be duly reconsidered and withdrawn.

(5) The reasons set forth above justify reconsideration and withdrawal of the restriction requirement, irrespective of unity of invention

The Office alleges that the combination of WO 97/46690 and Jagannath *et al.*, *Current Science* 82: 46 (2002) defeats a special technical feature that otherwise would unite the claims. Applicants request that the proposed combination of references be used in a rejection under 35 U.S.C. § 103, so that Applicants can respond appropriately to the Office’s allegation. The Office, however, does not possess unfettered discretion to restrict the claims, even when a reference allegedly teaches a technical feature that otherwise would provide unity of invention. *See* MPEP § 1850. Irrespective of the procedures in MPEP § 1850, however, the Office should reconsider and withdraw the restriction requirement for all the reasons set forth in items (1) – (4) above.


**CONCLUSION**

If there are any other fees due in connection with the filing of this Preliminary Amendment, please charge the fees to our Deposit Account No. 50-0573. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**DRINKER, BIDDLE & REATH LLP**

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Brian K. Lathrop, Ph.D., Esq.  
Registration No. 43,740

**CUSTOMER NO. 55694**  
**DRINKER, BIDDLE & REATH LLP**  
1500 K Street, N.W., Suite 1100  
Washington, D.C. 20005-1209  
Tel: (202) 842-8800  
Fax: (202) 204-0289